

***United States Court of Appeals
for the Second Circuit***



APPELLEE'S BRIEF

75-7308

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IN THE
United States Court of Appeals
FOR THE SECOND CIRCUIT

L. BATLIN & SON, INC.,

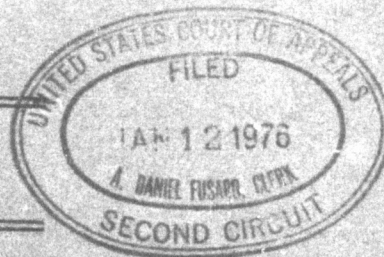
Plaintiff-Appellee,

—v.—

JEFFREY SNYDER, d/b/a J.S.N.Y. and
ETNA PRODUCTS Co., INC.,

Defendants-Appellants.

APPELLEE'S BRIEF ON REHEARING



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IN THE
UNITED STATES COURT OF APPEALS
For the Second Circuit

No. 75-7308

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L. BATLIN & SON, INC., :
Plaintiff-Appellee, :
v. : On Appeal from the Preliminary
JEFFREY SNYDER, d/b/a J.S.N.Y., : Injunction of the United
and ETNA PRODUCTS CO., INC., : States District Court for
Defendants-Appellants. : the Southern District of
New York
Honorable Charles M. Metzner,
District Judge
- - - - - x

APPELLEE'S BRIEF ON REHEARING

STATEMENT OF THE CASE

Defendants-Appellants* "Statement of the Case" does not adequately set forth either the procedural posture of this case or the facts, and is replete with legal arguments. Plaintiff therefore must present its own Statement of the Case.

*Defendants-Appellants will be hereinafter referred to as "Defendants" and Plaintiff-Appellee will be hereinafter referred to as "Plaintiff."

The Procedural Posture of This Case

Plaintiff, L. Batlin & Son, Inc., brought this action against the defendants, Jeffrey Snyder and Etna Products, Co., Inc., for a declaratory judgment declaring Snyder's copyright* invalid because the work purported to be covered by said registration was not originally created, designed or conceived by said defendant, since it had been in the public domain for almost one hundred years, because said defendant was not the author thereof, and further because said defendant failed to comply with the notice provisions of the Copyright Act. In addition, plaintiff sought damages for the unfair competition of defendants in attempting to stop plaintiff from selling its version of the public domain Uncle Sam Mechanical Bank by threatening plaintiff with suit and by blocking plaintiff's importation of said bank by recording their copyright with the Customs Service, and for restraint of trade under the Anti-trust Laws by the commission of several unlawful acts [A-3 to 11]**

Plaintiff was suffering irreparable damage, because its goods were being blocked from entry by defendants' recordation with the Customs Service. Plaintiff obtained an Order to

*Copyright No. Gp 95881, "Uncle Sam Bank."

**References to the Joint Appendix will be indicated as "[A-]"

Show Cause for a Temporary Restraining Order and a Preliminary Injunction [A-19 to 21]. The Temporary Restraining Order was granted by Judge Metzner. It restrained defendants from enforcing their copyright and compelled cancellation of the recordation thereof with the United States Customs Service. The Preliminary Injunction was granted after a full evidentiary hearing [A-119], which was requested by defendants, before the court below, which injunction continued in effect the restraints of the Temporary Restraining Order. Defendants appealed from the grant of the Preliminary Injunction and this Court reversed in an opinion dated October 24, 1975 (a copy of which is attached hereto as an Appendix). Plaintiff petitioned this Court for a Rehearing, requesting such rehearing en banc and said petition was granted in both respects.

The Facts of This Case

The plaintiff, L. Batlin and Son, Inc., has been in business since 1929 and is engaged in the design, importing, and sale of such goods as toys, novelty items, housewares, porcelain, china and glass, which goods are advertised and sold throughout all of the United States. It has been selling various types of novelty savings banks for at least 20 years [A-22 to 23].

Early in 1974, it learned that there were on the market cast iron replicas of antique American mechanical banks. Thereafter, it was offered a cast iron mechanical bank made in Taiwan, which bank was a replica of the same antique American mechanical banks then on the market, one of which was the bank known as the Uncle Sam Mechanical Bank [A-23]. On August 9, 1974, plaintiff placed its first order for a quantity of cast iron Uncle Sam Mechanical Banks [Exhibit 1, A-27]. On December 31, 1974, plaintiff's order was shipped from Taiwan [Exhibits 4, 5; A-30, 31].

In the latter part of 1974, plaintiff became aware of an Uncle Sam Mechanical Bank made of plastic which, in the opinion of its president, was an almost identical copy of the bank made of cast iron which it was already selling [A-23]. Plaintiff's trading company in Hong Kong procured a manufacturer and plaintiff placed an order for these plastic banks. The first samples of the plastic banks were received in the beginning of January, 1975 [A-32]. Plaintiff began to take orders for the plastic banks using its cast iron banks as samples and indicated to customers that it would be made in plastic. Orders based on the plastic samples received from Hong Kong were taken at the Housewares Show held in Chicago, January 10-15, 1975. As of May 1, 1975, plaintiff received orders for over 5,000 dozen of

these plastic Uncle Sam Mechanical Banks [A-24].

In March, 1975, plaintiff received 360 dozen plastic banks from Hong Kong, which were shipped out to its customers. In the beginning of April, 1975, plaintiff received 80 dozen plastic banks but was unable to ship the same since it was notified by the United States Customs Service that defendant, Jeffrey Snyder, had recorded with the Customs Service a copyright that allegedly covered the Uncle Sam Mechanical Bank. The Customs Service then advised plaintiff to return the 80 dozen banks to it. [A-24].

On February 5, 1975, plaintiff received a letter from the defendants' attorneys indicating that defendant, Jeffrey Snyder, had copyrighted the bank and demanding that plaintiff stop the sale thereof. This letter was answered by plaintiff's counsel [A-13]. As there were 2,000 dozen plastic banks en route from Hong Kong, plaintiff then sought injunctive relief against defendants, enjoining them from enforcing their copyright. In addition to the plastic Uncle Sam Mechanical Banks, the Customs Service was refusing entry to plaintiff's original cast iron banks by virtue of the recordation of defendants' above mentioned copyright. There were

also more cast iron banks on the water which would be held up in the same manner [A-24].

After Judge Metzner granted plaintiff's request for a Temporary Restraining Order, the court below, at the request of the defendants, held a full evidentiary hearing before deciding on whether or not to grant a Preliminary Injunction. For the purposes of the hearing, the only issue considered by the court below was the probability of plaintiff's success in proving defendants' copyright invalid at a trial on the merits on the ground that defendants' "bank" was an original, substantial copy of a work long since in the public domain. The plaintiff had already posted a bond upon the grant of the Temporary Restraining Order and there was no dispute as to the sufficiency thereof, or the fact that plaintiff was suffering irreparable injury. The other issues of invalidity due to improper copyright notice and authorship were never reached, the court below being satisfied that there was:

* * * little probability that defendants' copyright will be found valid in a trial on the merits [A-116]

on the ground of lack of originality.

At the evidentiary hearing below (contrary to defendants' statement in its brief), plaintiff's expert did not testify that sculpting steps were necessary and that a trained artist and sculptor would have had to spend considerable time in designing and sculpting Snyder's bank. What the expert said was that there was no degree of originality existing in defendants' bank over the one which had long been in the public domain, that defendants' bank was only a mere copy, and that there was little difference between the two [A-53 to 55]. Whatever differences there were, were made to facilitate the production of defendants' bank (that is, any changes made were utilitarian in nature)[A-56 to 57]. Thus, defendants' bank was stated by expert testimony to be a mere reproduction of a bank long in the public domain. Any variations were made as simple as possible for purposes of manufacture, the maker needing minimal skill. The defendants' bank was no more than a direct copy with proportionate changes in size [A-57 to 58]. None of the trivial differences were unique, artistic, or required any degree of originality [A-86].

Contrary to the statement in defendants' brief, there was no evidence as to who performed the various stages

in Snyder's so-called "creative process." No evidence was presented to indicate that any changes were made "because a new work was being created," that "Snyder's bank was not created with the intent of making differences between the Snyder and public domain banks" or that "because a new work was created, during the process of creation, the differences inevitably arose."

The only facts presented which related to the making of defendants' bank are contained in Snyder's affidavit [A-36 to 47]. Although defendants asked for the evidentiary hearing [A-85] and Jeffrey Snyder was present, he never took the witness stand. Indeed, all we are told by Snyder's affidavit is that the manufacturer's representative made some sketches with the public domain cast iron bank in front of him [A-38]. after which the manufacturer "Unitoy had made a clay model * * * presumably using the sketches as a guide for this clay model" [A-38, emphasis supplied]. After some discussion, "Unitoy promised to make a prototype in plastic." [A-39] Although Snyder affirms that the "design for an Uncle Sam bank is an original design which was produced under my direction and at considerable expense to me," [A-41], it is unclear who made the final design and what process was used. As far as the expense to Snyder, it appears that the other defendant, Etna Products Co., Inc., paid for one half, with the other half paid

for by the Japanese buying agent [A-39], Snyder paying nothing.

Defendants close their Statement of Facts with a list of differences which "were due to the aesthetic contribution of the artists and sculptors involved". There was no evidence before the District Court as to any contributions of any unnamed artists and sculptors. As far as the so-called differences, they are best described by Judge Oakes in his dissent:

The plastic bank's variations from the original or the up-dated version of the original also in the public domain consist essentially of three: a reduction in size from eleven to nine inches in height; the use of leaves instead of arrows in the clutches of the eagle at the base; and the joining of Uncle Sam's trousers at the ankle. But even the appellants' expert conceded that the steps performed in the copying of the metal bank into reduced plastic size involved changing some of the designs "in order to fit plastic." [24b]*

*References to this Court's decision reprinted in the annexed Appendix will be indicated as [__b].

ISSUES ON APPEAL

1. Was it an abuse of discretion for the District Court to grant a preliminary injunction against the defendants' enforcement of their copyright which prohibited plaintiff's goods from entering the country, based on the record before said court?

2. Is a virtually identical copy of a mechanical toy bank which has been in the public domain for over ninety years copyrightable?

3. Does this Circuit's line of cases requiring a modicum of originality for copyrightability support the copyrightability of a copy of a work in the public domain merely because said copy was made by a "skilled" moldmaker?

4. Are all works emanating from a mold made by a "skilled" moldmaker copyrightable merely because the moldmaker is skilled rather than unskilled, regardless of the presence of originality or the exercise of skill by the author?

ARGUMENT

I. The Court Below Did Not Abuse Its Discretion By Finding the Necessary Requisites Present for the Granting Of a Preliminary Injunction.

In reference to the power of the courts of appeal to review interlocutory orders granting an injunction, the Supreme Court stated:

The correct general doctrine is that whether a preliminary injunction shall be awarded rests in sound discretion of the trial court. Upon appeal, an order granting or denying such an injunction will not be disturbed unless contrary to some rule of equity, or the result of improvident exercise of judicial discretion. Meccano, Ltd. v. John Wanamaker, 253 US 136 (1920).

It must be kept in mind that this injunction was sought by plaintiff to enjoin the defendants from enforcing their copyright by registering the same with the Customs Service. Plaintiff had goods, including its own cast iron Uncle Sam bank, as well as its plastic Uncle Sam bank, which were being denied entry into the United States at the pier. It also had goods in transit [A-25]. Customers of plaintiff were cancelling orders because plaintiff could not deliver its own bank, and much good will would be lost if plaintiff was unable to live up to its commercial commitments [A-25 to 26]. It was against this background that the District Court granted plaintiff the injunction to enjoin defendants, requiring as a con-

dition the posting of a bond. The defendants never complained that the bond was insufficient. Indeed, any damage suffered by defendants would be easily measured by monetary damages, whereas plaintiff's damages would be irreparable.

The purpose of a preliminary injunction is to maintain the status quo until a trial can be had on the merits. 7 Moore's Federal Practice, Section 65.04 [1] (2d ed., 1974). The status quo which is to be preserved was very succinctly defined by Justice Clark in Ideal Toy Corp. v. Sayco Doll Corp., 302 F.2d. 623 (CA2, 1962):

The 'status quo' to be preserved is one grounded on the court's estimation of the respective legal rights of the parties.

The requirements necessary to be found for the grant of a preliminary injunction were clearly stated by the Court in West Virginia Highlands Conservancy v. Island Creek Coal Co., 441 F.2d 232, 235 (CA4, 1971):

It is sufficient if the court is satisfied that there is a probable right and a probable danger and that the right may be defeated, unless the injunction is issued, and considerable weight is given to the need of protection to the plaintiff as contrasted with the probable injury to the defendant.

Hence, the usual test establishes three elements that must be satisfied in order to grant a preliminary injunction:

first, the plaintiff must show a "probable right," i. e., a likelihood that plaintiff will prevail at the trial on the merits; second, there must be a "probable danger ... that the right may be defeated," which requires a showing of irreparable injury should the injunction not be granted; and, third, the need for protection of plaintiff's rights must clearly outweigh the possible injury to the defendants should the injunction issue, requiring a balancing of the equities between plaintiff and defendants. 7 Moore's Federal Practice, Section 65.04 [1] (2d. ed., 1974).

Nowhere in the proceedings below did defendants dispute plaintiff's showing of irreparable injury or that plaintiff's injury outweighed the possible injury to defendants. Therefore, as defendants agree, the court below had to find present only the remaining requirement, i. e., the probable right or the likelihood that plaintiff would prevail at the trial on the merits.

The majority erred when it stated in its opinion:

The District Court for the Southern District of New York (Metzner, J.), based its action granting the injunction upon a finding that the object of the purported copyright was not entitled to that protection. [2b]

In fact, the District Court, after an evidentiary hearing during which both sides presented expert witnesses, found:

... little probability that defendants' copyright will be found valid in a trial on the merits [A-116] [Emphasis added.]

Thus, the District Court found, on the basis of the testimony of both experts, that there was a probability that plaintiff would succeed at a full trial on the merits because plaintiff would be able to show that the defendants' so-called reproduction of a work of art was nothing more than a slavish copy of a work that had been in the public domain since June 9, 1893.

The decision of the District Court must be placed in its proper perspective. The court did not make a finding of invalidity of defendants' copyright when it granted the injunction. It merely found a likelihood that plaintiff would succeed at a trial based on the record before it. As far as the defendants' position is concerned, aside from their expert, they submitted only the affidavit of one of the defendants [A-36 to 47]. Factually, the affidavit was vague in describing the origin of the defendants' bank. It speaks of the manufacturer as if it were a person [A-38], and we are not privy as to how the final copy was made. For all we know, mechanical copying of some sort was used. All that is clear is that, at the first meeting, the manufacturer's representative made some sketches with the public

domain bank in front of him, although we do not know which of the many cast iron versions it was [A-38].

Together with defendant Snyder's affidavit, the Court observed the expert witnesses. Plaintiff's expert, a designer and model maker, was questioned closely by the Court [A-55 to 58]. The Court also had before it an example of the antique Uncle Sam mechanical bank and defendants' copy. The expert testified, inter alia, that defendants' bank was merely a copy of the antique bank [A-54], that the trivial changes between the two were made because it facilitated manufacture [A-56], that the changes were utilitarian [A-57], that defendants' bank was merely an aggregation of known components, a trivial variation, made as simple as possible for manufacturing purposes [A-57], and merely the result of proportionate changes in the original antique, lacking any artistic contribution [A-58].

Against this background, the Court below applied this Court's oft quoted test found in Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99 (CA2, 1951):

"'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' No matter how poor artistically the 'author's' addition, it is enough if it be his own." (Emphasis added.) [A-116 to 117]

and concluded that plaintiff would probably succeed at a trial. Snyder's affidavit, although far from sufficient, supplied enough to support a finding of "actual copying," and the expert's and the judge's own observations supported a finding that any variations were "trivial" and that the so-called "author" actually added nothing "recognizably his own" that "contributed" to the work.

II. The Holding That Defendants' Bank Should Be Granted Copyright Registration Now and Later Be Subject to Scrutiny Through Litigation Ignores the Fact that a Copyright Registration Gives the Copyright Owner the Right to Record His Registration With the Customs Service and Thereby Prohibit the Importation of Similar Items By Others

The rather cavalier approach of the majority that the objective of the copyright law is met by allowing registration now and permitting the courts to scrutinize it later would play havoc with the orderly business of importing. What this approach overlooks is that once the copyright registration is in hand, the owner can (as defendants did here) register it with the Customs Service under the provisions of Title 19, Code of Federal Regulations, Section 133, Sub Part D, and prohibit the importation of any similar appearing goods.* Once the copyright is registered with the Customs Service,

*19 CFR 133.42

similar looking goods are denied entry immediately, without any prior hearing.

Here, the registration of defendants' copyright caused the Customs Service to stop plaintiff's importation of its cast iron Uncle Sam bank, which it was importing before defendants ever had their plastic bank made. The Customs Service at the same time stopped importation of plaintiff's plastic banks. Although plaintiff has acted in accordance with the procedure under which it may deny that its articles are copies of a copyrighted work^{*}, there has been no decision to date. Therefore, but for the issuance of the injunction, plaintiff's goods would have been denied entry, causing plaintiff irreparable injury. It is unreasonable that plaintiff should be put to the burden of extensive litigation in order to overcome the casual granting of a copyright registration to a slavish copy of a work in the public domain. Such a bizarre result could hardly have been envisioned by the framers of the Constitution when they provided for the granting to authors of the exclusive rights to their writings for a limited time.

III. The Holding That Defendants' Bank Qualifies As a Reproduction of a Work of Art Overlooks the Misrepresentation Defendants Made to the Copyright Office.

Defendants registered their copyright as a

^{*}19 CFR 133.43

Work of Art in Class G. The majority opinion recognizes that the requirement of creativity is necessary to support such a registration but declines to decide if it is present [15b to 16b]. It is submitted, however, that it cannot so qualify. Title 37, Code of Federal Regulations, Section 202.10, specifically requires that the work must embody some creative authorship, and goes on to prohibit registration of any work covered by an issued design patent.

Contrary to the majority's statement that in 1886 a design patent was obtained on an eleven-inch high cast iron mechanical Uncle Sam bank [2b], Design Patent No. 16,720 covered a toy savings bank consisting of a base or pedestal, the figure of a man standing on the same, and a satchel resting on the base by the side of the figure [A-15]. As the Supreme Court stated in Gorham Company v. White, 81 U.S. (1871):

It is the appearance itself * * * that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.*

* See also, Schnadig Corporation v. Gaines Manufacturing Co., Inc., 494 F.2d 383 (CA6, 1974); Hadco Products, Inc. v. Walter Kidde & Company, 462 F.2d 1265 (CA3, 1972); and Schwinn Bicycle Company v. Goodyear Tire & Rubber Company, 444 F.2d 295 (CA9, 1970).

Thus, this appearance of a bank was the subject matter of a design patent and therefore unregistrable as a Work of Art under the Copyright Law.

The majority, however, proceeded to find defendants' bank protectable under Class H, Reproduction of A Work of Art, but in so doing, overlooked the misrepresentation made by defendants to the Copyright Office by the use of Form G, rather than Form H. If they had filed correctly, defendants would have had to complete line 7 in Form H which states:

If any substantial part of this work has been previously published, give a brief general statement of the nature of the new matter in this version.

Had the defendants been candid with the Copyright Office and stated the change made in size and medium and the change from arrows to leaves in the eagles' talons, the Copyright Office would have had an opportunity to refuse registration on the grounds that the changes were merely trivial. However, the Copyright Office had no such

opportunity. Consequently, by the use of the wrong form, defendants circumvented the requirements for registration of a claim to copyright in a reproduction of a work of art and failed to meet that degree of candor which is required of those who seek governmental monopolies.

IV. This Circuit's Line of Cases Requiring a Modicum of Originality To Support Copyrightability Is Eviscerated By the Majority's Holding, In Its Decision of October 24, 1975, That All Works Emanating From a Mold Are Copyrightable Merely Because the Moldmaker Is Skilled.

Chamberlain v. Uris Sales Corp., 150 F.2d 512

(CA2,1945) and its progeny have brought little clarification to the requirement of originality to support copyrightability. This is evidenced by the fact that the same cases are used by both plaintiff and defendants in support of their opposite positions. Alfred Bell & Co. v. Catalda Fine Arts, Inc., supra, 191 F.2d at 102-03 perhaps is most precise in calling for a contribution by the author of "something more than a 'merely trivial' variation, something recognizably 'his own.'" The majority fashioned a new test that the requisite of originality is satisfied if physical skill is necessary to create the work and if the person hired to sculpt the plastic mold (note, not

the author) needed "special skill, training and knowledge, and independent judgment" [16b]. This has the effect of rendering any molded article copyrightable, since molds by their nature must be made by skilled rather than unskilled persons who have special training and knowledge and independent judgment. Certainly, this is not the prevailing view of this Circuit, since it would accord copyrightability to slavish copies of any object in the public domain as long as they were molded and the mold was made by a skilled moldmaker.

Furthermore, as so aptly pointed out in the dissent, even in fashioning its unprecedented test, the majority ignored the substantial evidence in the record that comparatively small artistic skill and little independent judgment was involved in making defendants' bank, other than that required to transfer the metal design into the plastic medium with alterations dictated by the use of a different medium [A-56 to 59].

It is noteworthy to contrast this view of the majority with the methodical examination of the record, by Judge Metzner in the court below, and the application by him of the test that hitherto was this Circuit's test for originality, as espoused in the Altred Bell case, supra. His conclusion, it is submitted, is correct according to the prevailing line of cases:

Defendants contend that the concept of originality embraces a mere copying if it requires artistic skill to achieve the finished product. The court agrees that in this case a degree of physical artistic skill was necessary to produce the plastic article. What defendant overlooks is that this artistic skill must contribute to the work. It must be more than a "merely trivial variation," which is all that is present here. The need for artistic skill in the execution of the copy is not sufficient. [A-117]

Judge Oakes, in his dissenting opinion, also carefully examined the variations of defendants' bank from the original and found they consisted essentially of three: a reduction in size from eleven to nine inches in height, the use of leaves instead of arrows in the talons of the eagle on the base; and the joining of Uncle Sam's trousers at the ankle. After noting that even defendants' expert conceded that the steps performed in the copying of the metal bank into the reduced plastic size involved changing some of the designs to "fit the plastic" [A-94 to 95], Judge Oakes agreed with the District Court's refusal to dignify these changes as an author's contribution of more than "trivial variation," and its consignment of defendants' bank to the class of items which are "slavishly copied" and undeserving of copyright protection. Rushton v. Vitale, 218 F.2d 434 (CA2, 1955). As Judge Oakes so aptly stated:

That the plastic bank was copied from the metal bank in virtually every detail was apparent to the experts, to the trial judge, and also from the exhibits submitted, to this writer as well . . . [23h]

Thus, the majority has seemingly ignored the substantial evidence that was before the court below, that, other than that skill and judgment required to transfer the design of the original 90 year old cast iron bank into plastic with those changes dictated by the use of the different medium, comparatively small artistic skill, and little independent judgment, was involved in making defendants' bank.

Perhaps it would be more accurate to state that the majority's opinion reflects a misapprehension of the testimony of plaintiff's expert witness. The majority stated:

* * * From the record, it appears that witnesses for both parties concede that the sculptor needed special skill, training and knowledge, and independent judgment to create the mold * * * There was no slavish or mechanical copying. [16b]

However, there was no concession on the part of plaintiff's expert, far from it. Plaintiff's expert witness testified that there was no degree of originality existing in defendants' bank over the one in the public domain, that defendants' bank was only a mere copy, and that there was little change between the two [A-53 to 55]. Whatever changes were made were made to facilitate the production of defendants' bank; that is, any

changes were utilitarian [A-56 to 57]. In summary, defendants bank is a reproduction of the public domain bank with trivial variations, made as simple as possible for purposes of manufacture, the maker needing minimal skill, and no more than a direct copy with proportionate changes in size [A-57 to 58]. None of the trivial differences were unique or artistic or required any degree of originality [A-86].

From an examination of the full testimony, plaintiff's expert concludes that the only departures from the original bank were those necessary to reduce its size and to facilitate the use of plastic instead of metal. Surely, such changes do not meet the standard of originality as heretofore required by this Court in past decisions. As to the statement that there was no slavish or mechanical copying, as previously stated, the affidavit evidence of defendants is so vague as to make such statement mere speculation.

The majority's holding that the defendants are entitled to stake out their claim to a reproduction of an object of art within the public domain renders such a copyright meaningless. The majority recognizes that the test for infringement is whether the average lay observer would recognize an alleged copy as having been appropriated from the copyrighted work. Herbert Rosenthal Jewelry Corp. v.

Honora Jewelry Co., Inc., 509 F.2d 64 (CA2,1974). If defendants' bank is virtually identical in every detail to the public domain bank, and another also copies virtually every detail, how then can the average lay observer be expected to recognize whether the other copy was copied from defendants' or from the public domain work? Consequently, such copyright on defendants' bank would be meaningless.

The majority follows this questionable holding with another equally questionable, or, rather, erroneous one; namely, that "it is possible for one valid copyright to infringe upon another valid copyright." [12b] Such a position was specifically rejected by the Supreme Court over sixty years ago in Ferris v. Frohman, 223 US 429 (1911). In that case, the authors of a play sought to enjoin an unauthorized adaptation which "differed from the original in various details, but not in its essential features." Since the adaptation was copyrighted, the owner claimed such copyright gave him rights thereto. The court held that the adaptation was simply a practical composition, stating:

It was not the purpose or effect of the
the copyright law to render secure the
fruits of piracy* * *

Thus, the majority's position that the copyright law was

intended to protect virtually identical copies of other works, whether such copies are copyrighted themselves or in the public domain, is untenable.

Judge Dooling was faced with a similar problem in Kuddle Toy, Inc. v. Pussycat-Toy Co., Inc., reported only at 183 USPQ 642 (EDNY, 1974). However, he refused to find that the copyright law was meant to protect trivial variation of works in the public domain. He explained his position thusly:

The language [of the Copyright Act] does not mean, without impossibly strenuous interpretation, that the applicant may be the author of a trifling variation, perhaps the result of imperfect copying, of some other man's work of art. Copying is not authorship of what is copied.

It is ironic that the District Courts in this Circuit and other Circuit and District Courts* apply what they believe to be the touchstone of the law determining copyrightability as enunciated by this Circuit, only to have such standard disregarded by the majority in its opinion herein.

* See also, Gardenia Flowers, Inc. v. Joseph Markowitz, Inc., 280 F.Supp. 776 (SDNY, 1968); Donald v. Zack Meyer's T.V. Sales and Service, et al., 426 F.2d 1027 (CA5, 1970) and cases cited therein.

CONCLUSION

The Majority Decision of this Court, reversing the court below, radically departs from the settled law of this Circuit by conferring copyrightability on any article that is produced by a skilled as opposed to an unskilled artisan, merely by virtue of his being skilled and without regard to the absence of creativity or originality. The Majority Decision should therefore be vacated and superseded by a decision from this Court en banc that reaffirms this Circuit's requirement that to support copyrightability the author must contribute something original to the work, and in the case of a reproduction of a work in the public domain, the changes must be more than merely trivial.

Respectfully submitted,

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APPENDIX

Decision of October 24, 1975
U. S. Court of Appeals, Second Circuit
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 1249—September Term, 1974.

(Argued August 11, 1975 Decided October 24, 1975.)

Docket No. 75-7308

L. BATLIN & SON, INC.,

Plaintiff-Appellee,

v.

JEFFREY SNYDER, d/b/a J.S.N.Y. and
ETNA PRODUCTS CO., INC.,

Defendants-Appellants.

Before:

OAKES, VAN GRAAFEILAND and MESKILL,

Circuit Judges.

Appeal from an injunction granted by the District Court for the Southern District of New York, Charles M. Metzner, *J.*, restraining appellant Snyder from enforcing his copyright and interfering with the appellee's importation of a possibly infringing toy bank. The district court found that there was a clear showing of probability of success on the merits because the toy bank was with minor variations taken from the public domain and was not copyrightable. (Reported below at 394 F.Supp. 1389.)

Reversed.



MARK H. SPARROW, New York, New York (Jacobs & Jacobs, P.C., New York, New York, of counsel), *for Plaintiff-Appellee*.

ROBERT C. FABER, New York, New York (Marc S. Gross, Ostrolenk, Faber, Gerb & Soffen, New York, New York, of counsel), *for Defendants-Appellants*.

MESKILL, *Circuit Judge*:

The appellants, Jeffrey Snyder and Etna Products Co., Inc. (For the sake of convenience, the appellants herein will be referred to collectively as "Snyder"), appeal from a preliminary injunction in favor of the appellee, L. Batlin & Son, Inc. ("Batlin") compelling Snyder to cancel a recordation of a copyright with the United States Customs Service, and restraining him from enforcing that copyright. The District Court for the Southern District of New York (Metzner, *J.*), based its action granting the injunction upon a finding that the object of the purported copyright was not entitled to that protection. We reverse, and vacate the preliminary injunction.

I. FACTUAL BACKGROUND

In 1886 a design patent was obtained on an eleven-inch high cast iron mechanical Uncle Sam bank. This bank ("basic bank") passed into the public domain when the patent protection expired some time prior to 1909. Act of July 8, 1870, c. 230 § 73, 16 Stat. 210, now 35 U.S.C. § 173. In the spring of 1974, Snyder procured a sculptor to model a nine-inch replica of the original bank. The smaller model was transformed into a mold. From that mold, plastic versions of the Uncle Sam bank ("Snyder bank") were produced in Hong Kong and shipped to this country for sale by Snyder. The nine-inch plastic bank

and the original eleven-inch metal bank are generally similar. Each consists of a representation of "Uncle Sam" attired in patriotic garb, standing on a soap box with a carpetbag at his side. Uncle Sam accepts a coin placed into his outstretched right hand, and, when the donor presses a lever, Uncle Sam deftly inserts the coin into his bag. His mouth opens and closes as if to say "thank you."

Snyder obtained a copyright on his version of the bank, claiming it to be a work of art.¹ See, e.g., *Royalty Designs, Inc. v. Thriftneck Service Corp.*, 204 F.Supp. 702, 703 (S.D.N.Y., 1962). Subsequently, Batlin attempted to import his own plastic version of the bank which was also produced in Hong Kong. Batlin claims that he was substantially blocked from this endeavor by the United States Customs Service, which, presumably, at Snyder's behest, refused to permit entry of this other bank, pursuant to Customs Regulations which permit the exclusion of pirated or infringing goods, 19 C.F.R. § 133. He further claims that he received a letter from Snyder threatening suit should he persist in marketing the bank. Thereupon, Batlin filed suit in district court, seeking a declaratory judgment and damages from claims of unfair competition and violation of antitrust law, and requesting relief in the form of preliminary and permanent injunctions.² Batlin

¹ 17 U.S.C. § 5(g), set forth in Footnote 8. If the item does not fall under (g) as a work of art, the mistake in designation of the appropriate subsection of the law in the application is not fatal. If the object falls into any other category of copyrightable items, it is protected nevertheless. 17 U.S.C. § 5; *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir., 1974), cert. denied, 416 U.S. 986; *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F.Supp. 1366, 1368 (S.D.N.Y.), aff'd. 415 F.2d 1007 (2d Cir., 1969).

² The plaintiff also joined the United States Customs Service in its suit and its request for preliminary relief. It requested the district court to enjoin the Customs Service from enforcing the defendants' copyright and excluding entry to the plaintiff's bank. The court's action in dismissing that portion of the action is not at issue on this appeal.

alleged that it will suffer irreparable damage by virtue of loss of profits and goodwill, due to its inability to live up to its commitment to deliver orders because of the Customs Service ban on importation of its bank.

This is not the first time that the district court has had to deal with "Uncle Sam's" fate. *Etna Products and Jeffrey Snyder, d/b/a J.S.N.Y. v. E. Mishan & Sons*, 75 Civ. 428 (S.D.N.Y., 1975) was an earlier case launched by Snyder, wherein he sought a preliminary injunction, claiming copyright infringement and unfair competition. The district court granted relief to Snyder on the unfair competition ground only, finding that it had serious doubts as to whether the copyright could be sustained.³ Consistently with its determination in that case, the same court had difficulty with the copyrightability of Snyder's bank in the instant case. It noted that "to support a valid copyright as a reproduction, only originality is required. *Gardenia Flowers, Inc. v. Joseph Markowits, Inc.*, 280 F.Supp. 776 (S.D.N.Y., 1968); *Nimmer on Copyrights*, § 20.3." The court went on to say "... [Snyder] contends that the concept of originality embraces a mere copying if it requires artistic skill to achieve the finished product. The [District] Court agrees that in this case a degree of physical artistic skill was necessary to produce the plastic article. What [Snyder overlooks] is that this artistic skill must *contribute* to the work. It must be more than a *merely trivial variation*, which is all that is present here. The need for artistic skill in the execution of the copy is not sufficient [to satisfy the need for copyrightability]." The court went on to conclude that since there was little probability that the Snyder bank would be held to be copyrightable, there was a clear showing that Batlin would

³ That case, *Etna Products and Jeffrey Snyder, d/b/a J.S.N.Y. v. E. Mishan & Sons*, is being held in abeyance pending the outcome of this appeal, in which E. Mishan & Sons has participated as *amicus curiae*.

probably succeed at a trial on the merits.⁴ Thereupon, the district court granted Batlin's application for a preliminary injunction, restrained Snyder from enforcing his copyright and ordered him to cancel his recordation of it with the United States Customs Service pending adjudication of the issue on the merits.

Upon appeal, an order granting or denying a preliminary injunction will not lightly be disturbed, unless it contravenes some rule in equity or is the result of improvident exercises of judicial discretion. *Meccano Ltd. v. John Wannamaker, New York*, 253 U.S. 136, 140 (1920); *American Visuals Corp. v. Holland*, 219 F.2d 223, 224 (2d Cir., 1955); *Joshua Meir Co. v. Albany Novelty Mfg. Co.*, 236 F.2d 144, 146 (2d Cir., 1956).⁵

Works within the public domain are rendered noncopyrightable by 17 U.S.C. § 8.⁶ Although the basic bank is itself excluded from copyright protection, Snyder's repro-

⁴ It appears that the parties have conceded the existence of irreparable harm, hence that issue is not before us. However, with respect to an injunction restraining the appellants from enforcing their copyright with the United States Customs Service, it does not appear from the record that the issue of the appellee's exhaustion of remedies with the Customs Service was raised. A determination on this issue could conclude the case.

⁵ *Amicus E. Mishan & Sons'* argument that the injunction should be sustained in order to preserve the *status quo* is not well taken. The injunction changed the *status quo* by preventing the appellant from enforcing the copyright. Actions temporarily enforcing a copyright, thereby barring parties from doing business, have been sustained, pending litigation. *Omega Importing Corp. v. Petri-Kline Camera Co.*, 451 F.2d 1190, 1197 (2d Cir., 1971), *cert. denied*, 408 U.S. 943; *American Code Co., Inc. v. Bensinger*, 282 F. 829, 835 (2d Cir., 1922).

⁶ 17 U.S.C. § 8 states in pertinent part:

"§ 8. Copyright not to subsist in works in public domain, or published prior to July 1, 1909, and not already copyrighted . . .

No copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to July 1, 1909, and has not been already copyrighted in the United States"

duction of it is copyrightable if it may be regarded as an adaptation of a work of art in the public domain, 17 U.S.C. § 7.⁷ It may qualify either as a work of art, 17 U.S.C. § 5(g) as claimed in Snyder's application, or as a reproduction of a work of art, 17 U.S.C. § 5(h).⁸ Thus the fact that an idea is in the public domain does not render an expression of that idea uncopyrightable. *Donald v. Uarco Business Forms*, 478 F.2d 764, 766 (8th Cir., 1973); *M. M. Business Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1139 (6th Cir., 1973); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 445 (2d Cir., 1960) (dictum). See also: *American Code Co., Inc. v. Bensinger*, 282 F. 829, 834 (2d Cir., 1922); *Axelbank v. Rony*, 277 F.2d 314, 317 (9th Cir., 1960); *Continental Casualty v. Beardsley*, 253 F.2d 702 (2d Cir., 1958), *cert. denied*, 358 U.S. 816; *Alfred Bell &*

7 § 7. Copyright on compilations of works in public domain or of copyrighted works; subsisting copyrights not affected . . .

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

8 That section provides, in pertinent part, as follows:

§ 5. Classification of works for registration. . . .

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

* * * * *

(g) Works of art; models or designs for works of art.

(h) Reproductions of a work of art.

* * * * *

The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secured under this title.

Co., Ltd. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir., 1951); *Dorsey v. Old Surety Life Ins. Co.*, 98 F.2d 872, 873 (10th Cir., 1938); *Grove Press, Inc. v. Collectors Publication, Inc.*, 264 F.Supp. 603 (C.D.Cal., 1967); *But Cf. Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 17, 18 (9th Cir., 1933), *cert. denied*, 296 U.S. 669. Hence, the instant appeal presents the question of determining whether this reproduction of a work in the public domain is a fit subject for protection under the copyright laws as a work of art, or as a reproduction of a work of art. The record, fortified by the district court's carefully formulated findings, is sufficiently ripe for appellate review. We must determine whether Uncle Sam can ever attain the status of art, or forever be condemned to an ignoble and unprotected commercial status. *Eg. Rushton v. Vitale*, 218 F.2d 434, 436 (2d Cir., 1955).

II. "WORK OF ART" AND COPYRIGHTABILITY

The difficulty in fashioning a precise definition for the term "work of art" is manifest. We are faced with the task of formulating an expression sufficient to guide judicial interpretation with consistency, without imposing a new orthodoxy over esthetic sensibility. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). Webster devotes more than half a column in an attempt to define the term, the pertinent parts of which are reproduced in the margin.⁹ 37 C.F.R. § 202.10, the Copyright

⁹ Webster's Third New International Dictionary (Unabridged) (1961) states:

. . . Systematic application of knowledge or skill in effecting a desired result . . . application of skill and taste to production according to aesthetic principles: the conscious use of skill, taste, and creative imagination in the practical definition or production of beauty . . . the product of skill and taste applied according to aesthetic principles: expression of beauty . . . ART is the most variable of these words in meaning, often interchangeable with,

Office Regulations, are no more specific in formulating a workable test.¹⁰

In order to properly understand the term as it should be applied, we must analyze the purpose of the copyright legislation in the light of history. *Metro-Goldwyn-Mayer D. Corp. v. Bijou Theatre Co.*, 59 F.2d 70, 76 (1st Cir., 1932). The law of copyrights evolved from two roots: common law and legislation. The former concerned the right of an author to initially publish works identical to his own. 2 Blackstone, Commentaries (1766) Ch. 26, § 8. *See Public Affairs Associates, Inc. v. Rickover*, 284 F.2d 262, 267 (2d Cir., 1960). The latter developed as a means of protecting the correctness of the copies, and not the property rights of the author. It was a type of quality-control device, later extended to protect the printer's rights. Under Henry VIII (1533), it was utilized to pro-

often contrasting with, the others: [skill, craft, artifice] its significant weight can fall upon recondite, inventive, or creative power. It can, like SKILL, suggest proficiency or expertness . . . or, like CRAFT, or, rarely, like ARTIFICE, can point to skill, ingenuity, and inventiveness in contriving even though the act or result lacks any true creative force or quality. . . . But more frequently and in its most distinct sense ART contrasts with SKILL, ARTIFICE, and CRAFT in putting stress upon something more, in implying a personal, un-analyzable creative force that transmits and raises the art or product beyond a skill, artifice, or craft though it may involve the essential elements of all of these

¹⁰ 37 C.F.R. § 202.10:

§ 202.10 Works of art (Class G).

(a) General. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile

tect England's printers from foreign competition.¹¹ Later it was used for the purpose of suppressing sedition. Both, however, concerned the protection of literary works and revolved around the growth of printing.¹² R. R. Bowker, *Copyright: Its History and Its Law*, 8-41; e.g., *United States v. Steffens*, 100 U.S. 82, 94 (1879).

It is only in the mid-nineteenth century that the copyright protection was extended to works of art and reproductions of them.¹³ The continued expansion of the ambit of copyright protection is merely a transposition of the same type of protection accorded to written works to different modes of expression. *Markham v. A. E. Borden Co.*, 206 F.2d 199, 202 (1st Cir., 1953) (Dictum); note, Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following *Mazer v. Stein*, 28 U.Chi.L.Rev. 807, 808. The extension of the law did not increase the scope of the protection afforded; it merely added to the list of subjects covered. In this respect it is critical to note that the scope of the

product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

11 This protectionist element survives, see 17 U.S.C. § 16.

12 Except perhaps in Roman times. See R. R. Bowker, *Copyright: Its History and Its Laws*, 8.

13 The Copyright Act of 1870 extended coverage to "paintings, drawings, choromos, statutes, [sic] statuary and models and designs intended to be perfected as works of the fine arts." R.S. § 4952 (Act of July 8, 1870, c. 230 § 86). See *Mazer v. Stein*, 347 U.S. 201, 204 (1954).

protection extended only to the particular expression of an idea and never to the idea itself. *Mazer v. Stein*, 347 U.S. 201, 217 (1954); *Baker v. Selden*, 101 U.S. 99, 102-103 (1897); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 906 (3d Cir., 1973); *M. M. Business Forms Corp., v. Uarco, Inc.*, *supra*, 472 F.2d 1137, 1139; *Uneeda Doll Co., Inc. v. P & M Doll Co., Inc.*, 353 F.2d 788, 789 (2d Cir., 1965); *Welles v. Columbia Broadcasting System*, 308 F.2d 810, 814 (9th Cir., 1962); *Eisenschiml v. Fawcett Publications*, 246 F.2d 598, 603 (7th Cir., 1957), *cert. denied*, 355 U.S. 907; *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir., 1945); *R. C. A. Mfg. Co. v. Whiteman*, 114 F.2d 86, 90 (2d Cir., 1940), *cert. denied*, 311 U.S. 712; *Guthrie v. Curlett*, 36 F.2d 694, 696 (2d Cir., 1929); *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir., 1926); *Emerson v. Davies*, (1845) 8 Fed. Cas. 615, 618-621 (Story, Justice). The protection of ideas exists, if at all, in patent legislation. *Mazer v. Stein*, *supra*, 347 U.S. 201. Hence the term "art" is used in a generic and not qualitative sense: the article to be copyrighted need not constitute a substantive advance in a concept, but it is sufficient if it is an expression of a concept already in existence.

The reason for the distinction between idea and expression is basic to the difference between patent and copyright laws. Patents require a considerable amount of novelty not required by copyrights. *Mazer v. Stein*, 204 F.2d 472, 474 (4th Cir., 1953), *aff'd*, 347 U.S. 201; *Baker v. Selden*, *supra*, 101 U.S. 99; *Wheaton v. Peters*, 33 U.S. (8 Peters 591) 223, 234; *Thomas Wilson & Co. v. Irving Dorfman Co.*, 433 F.2d 409, 411 (2d Cir., 1970), *cert. denied*, 401 U.S. 977; *Gelles-Widmer Co. v. Milton Bradley Co.*, 313 F.2d 143, 146 (7th Cir., 1963), *cert. denied*, 373 U.S. 913; *National Comics Publication v. Fawcett Publications, Inc.*, 191 F.2d 594, 599 *modified* 198 F.2d 927 (2d Cir., 1951) (L. Hand, J.). Patents concern generally ideas,

inventions which can be applied to an indefinite number of applications. *Perris v. Hexamer*, 99 U.S. 674 (1878). Copyrights, however, refer to creations which are expressions of ideas. A most basic exposure to the history of art will provide ample proof that while a core concept may remain unchanged, its manifestation in artistic work varies sharply with its cultural and historical surroundings. This is readily apparent in the commercial context: today's fashions are tomorrow's castaways; yesterday's news is old hat (and need not be tomorrow's history). Although the literary expression of news is copyrightable, the factual subject matter is not. *International News Service v. Associated Press*, 248 U.S. 215, 234 (1918); *Chicago Record-Herald Co. v. Tribune Ass'n.*, 275 F. 797, 798 (7th Cir., 1921). Thus copyrightable works of art often have value for only a short time span, and are useful in a very limited historical and cultural context. See, e.g. *Millworth Converting Corporation v. Slifka*, *supra*, 276 F.2d 443, 444; *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1093 (2d Cir., 1974), *cert. denied*, 416 U.S. 986.¹⁴ Consequently, since it is merely the *representation* of ideas which is protected, and that expression is so time-bound (in an historical and cultural context), only a very low standard must be satisfied for a work to pass muster with respect to copyrightability. *Bleistein v. Donaldson Lithographing Co.*, *supra*, 188 U.S. 239; *Universal Athletic Sales Co. v. Salkeld*, *supra*, 511 F.2d 904, 908; *Donald v. Uarco Business Forms*, *supra*, 478 F.2d 704, 765; *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir., 1970), *cert. denied*, 401 U.S. 977; *H. M. Kolbe Co. v. Armigus Textile Co.*, 315 F.2d 70, 72 (2d Cir., 1963); *Adventures in Good Eating v. Best Places to Eat*, 131 F.2d 809, 812 (7th Cir., 1942).

¹⁴ All parties concede that the bank's commercial value is greatly time-bound, because it is marketed with the Bicentennial celebration in mind.

This time limitation also rationalizes from an operational viewpoint the differences between the patent office and the copyright office. *Weir v. Gordon*, 111 F.Supp. 117, 123 (E.D.Mich.), *aff'd*, 216 F.2d 508 (6th Cir., 1954). The patent office provides an elaborate but time-consuming search mechanism designed to prevent infringements or interference and to insure novelty of the idea. The copyright office regulations have no such provisions. Compare 35 U.S.C. Chs. 12 and 13 with 17 U.S.C. and 37 C.F.R. Ch. 1 with 37 C.F.R. Ch. 2. Unless an article does not fall into a copyrightable category it will be entitled to copyright protection if the parties follow the proper procedures.

The primary purpose of copyrights, as mandated by the Constitution, Art. 1, § 8, Cl. 8, is "to promote the Progress of Science and the Useful Arts . . ."; financial reward is secondary. *United States v. Paramount Pictures*, 334 U.S. 131, 158 (1947); *Twentieth Century Music Corp. v. Aiken*, 500 F.2d 127, 130, n. 6 (3d Cir., 1974), *cert. denied*, 416 U.S. 1067; *Berlin v. E. C. Publications, Inc.*, 329 F.2d 541, 543 (2d Cir., 1964), *cert. denied*, 379 U.S. 822; *Continental Casualty v. Beardsley*, *supra*, 253 F.2d 702, 704, *cert. denied*, 358 U.S. 816; *Becker v. Loews, Inc.*, 133 F.2d 889, 891 (7th Cir., 1943), *cert. denied*, 319 U.S. 772. Progress in the arts connotes rapid dissemination. A copyright becomes akin to a notice or a claim for priority amongst creditors. The claims can be staked out rapidly so that articles of culturally perishable content can rapidly enter the stream of commerce. Thus it is possible for one valid copyright to infringe upon another valid copyright. *See infra*.

In order for copyright protection to have any commercial meaning in this context, however, the standards relating to infringement must be much higher than those relating to mere copyrightability.

In *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir., 1971), Judge Friendly pointed out this other distinction so crucial to our analysis. He noted that the standards for determining whether an object is copyrightable differ from the standards applied to determine whether an object infringes upon a copyright. Cf. *Millworth Converting Corporation v. Slifka*, *supra*, 276 F.2d 433; *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, *supra*, 191 F.2d 99, 102, 104, n. 2; *Helm v. Universal Pictures Co.*, 154 F.2d 480, 488, n. 17 (2d Cir., 1946); *Alva Studios, Inc. v. Wininger*, 177 F.Supp. 265, 267 (S.D.N.Y., 1959); See *Universal Athletic Sales Co. v. Salkeld*, *supra*, 511 F.2d 904, 908. The different levels of creativity to be applied to these two situations can be understood from the nature of the interest protected and the means for effectuating that protection, as provided in the statutes and regulations discussed above.

"The test of copyright infringement is whether similarity between the products would lead 'the average lay observer . . . [to] recognize [an] alleged copy as having been appropriated from the copyrighted work.'" *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc.*, 509 F.2d 64, 65 (2d Cir., 1974). Hence there can be an infringement if there is a substantial similarity between the items in question. *Id.*; *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, *supra*, 490 F.2d 1092, 1093, *cert. denied*, 416 U.S. 986. The infringer must act at his peril, because a truly innocent infringement is unlikely. *Mazer v. Stein*, *supra*, 347 U.S. 201; *H. M. Kolbe Co. v. Armagus Textile Co.*, *supra*, 315 F.2d 70, 72. In contradistinction to infringement, an article need only fall into the proper category of articles in order to be copyrightable. Such an article can still constitute an infringement of another copyright. *Weir v. Gordon*, *supra*, 111 F.Supp. 117, 123,

aff'd, 216 F.2d 508; *e.g. Patterson v. Century Productions, Inc.*, 93 F.2d 489, 491 (2d Cir., 1937), *cert. denied*, 303 U.S. 655; *Harold Lloyd Corp. v. Witwer, supra*, 65 F.2d 1, 17, *cert. denied*, 296 U.S. 669; *but see American Code Co. v. Bensinger*, 282 F. 829, 833 (2d Cir., 1922). The objective is to progress now and, if necessary, litigate later; let the courts determine which party is entitled to damages should it find infringement. In the meantime, the public culture benefits from progress; the issue of who is entitled to profits should not induce rigidity and slowness in industries and fields naturally subject to great flux.

Consequently, for purposes of copyrightability, the issue of whether an article is an object of art or not narrows to a judgment as to fact, and not a judgment of artistic sensibility. *Tennessee Fabricating Co. v. Moultrie Manufacturing Co.*, *supra*, 421 F.2d 279, 281, *cert. denied*, 398 U.S. 928; *George Hensher Ltd. v. Restawile Ltd.* (1974) 2 All.E.R. 420, 426. The tests imposed for copyrightability, are as indicated by the previous discussion, at best, minimal. Art, for the purposes of copyright law has two requisite elements: creativity and originality. *See: United States v. Steffens, supra*, 100 U.S. 82, 94 (dictum); *Emerson v. Davies, supra*, 8 Fed.Cas. 615, 618-21; *Donald v. Uarco Business Forms, supra*, 478 F.2d 764, 765; *Tennessee Fabricating Co. v. Moultrie Manufacturing Co.*, *supra*, 421 F.2d 279, 281, *cert. denied*, 398 U.S. 928; *Drop Dead Co. v. S. C. Johnson & Son, Inc.*, 236 F.2d 86, 92 (9th Cir. 1963); *Rushton v. Vitale, supra*, 218 F.2d 434, 435; *McIntyre v. Double-A Music Corp.*, 179 F.Supp. 160, 162 (S.D.Cal., 1959); *Dunham v. General Mills, Inc.*, 116 F.Supp. 152, 154 (D.C.Mass., 1953); Nimmer on Copyrights §§ 191, 192. Creativity can be determined from observing the object itself in comparison with others; originality can be gauged from evaluating the process by which the object was made.

Creativity in this context means only that the object created be more than a trivial variation from what existed before. This implies a modicum of novelty. It has been said in many cases that novelty is not required in order to satisfy the requirements for copyrightability. *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir., 1970); *Donald v. Zack Meyer's T.V. Sales and Service*, 426 F.2d 1027, 1029 (5th Cir., 1970), *cert. denied*, 400 U.S. 992; *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, 280 F.2d 800, 802 (2d Cir., 1930); *Whitol v. Wells*, 231 F.2d 550, 553 (7th Cir., 1956); *Mazer v. Stein*, *supra*, 204 F.2d 472, 474, *aff'd*, 347 U.S. 201, 218; *Cf. J. C. Lahore*, Art and Function in the Law of Copyright and Designs, 4 Adelaide L.Rev. 183, 200. There have been some cases to the contrary, however. *See: Rushton v. Vitale*, *supra*, 218 F.2d 434, 435.¹⁵ This apparent conflict can be rationalized, however, to mean that the degree of novelty required for patentability need not be reached for copyrightability. *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, *supra*, 433 F.2d 409, 411, *cert. denied*, 401 U.S. 977; *Gelles-Widmer Co. v. Milton Bradley Co.*, *supra*, 313 F.2d 143, 146, *cert. denied*, 373 U.S. 913; *Mazer v. Stein*, *supra*, 204 F.2d 472, 474 (4th Cir., 1953), *aff'd*, 347 U.S. 201; *National Comics Publications v. Fawcett Publications, Inc.*, *supra*, 191 F.2d 594, 599; *Riker v. General Electric Co.*, 162 F.2d 141, 142 (2d Cir., 1947). Since the objects adjudged are cultural commodities, upon which there is often heated debate in a free society, creativity requires only a minor quantum of difference from

15 *Universal Athletic Sales Co. v. Salkeld*, *supra*, 511 F.2d 904; *M. M. Business Forms Corp. v. Uarco*, *supra*, 472 F.2d 1137; *Puddu v. Buonomici Statuary, Inc.*, *supra*, 450 F.2d 401, 402; *Dan Kasoff, Inc. v. Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir., 1962); *Gerlach-Barklow Co. v. Morris Bendien*, 23 F.2d 159, 161 (2d Cir., 1927). *See also: McIntyre v. Double-A Music Corp.*, *supra*, 179 F.Supp. 160, 161; *Dunham v. General Mills, Inc.*, *supra*, 116 F.Supp. 152, 154.

others before it. After all, cultural progress tends to occur incrementally.

By originality, the *process* of the creation is analyzed, and the item is not subject to copyrightability unless it had been constructed by a process requiring independent skill, labor and judgment of an individual. *United States v. Steffens*, *supra*, 100 U.S. 82, 94 (dictum); *Roth Greeting Cards v. United Card Co.*, *supra*, 429 F.2d 1106, 1109; *Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir., 1967), *cert. denied*, 389 U.S. 832; *Lin-Brook Builders Hardware v. Gertler*, 352 F.2d 298, 301 (9th Cir., 1965); *Yale University Press v. Row, Peterson & Co.*, 40 F.2d 290, 292 (S.D.N.Y., 1930); *National Institute, Inc. v. Nutt*, 28 F.2d 132 (D. Conn., 1928), *aff'd*, 31 F.2d 236, 237 (2d Cir., 1929). *Cf. Columbia Broadcasting System Inc. v. Melody Recordings, Inc.*, 44 U.S.L.W. 2026 (N.J. App.); Bergstrom, *The Literary and Artistic Work in Copyright*, 20 Bull. C.R. Soc. 67, 68-69.

The trial court in the instant case found that physical skill was necessary to produce the Snyder bank. From the record, it appears that witnesses for both parties concede that the sculptor needed special skill, training and knowledge, and independent judgment to create the mold. *See Mazer v. Stein*, *supra*, 204 F.2d 472, 473, *aff'd*, 347 U.S. 201; *Smith v. George E. Muelbach Brewing Co.*, 140 F.Supp. 729, 731 (W.D.Mo., 1956). The mold was sculpted independently, from scratch. There was no slavish or mechanical copying. *Shapiro, Bernstein & Co., Inc. v. Miracle Record Co., Inc.*, 91 F.Supp. 473, 474 (N.D.Ill., 1950). With this, the requisite of originality was satisfied. The district court went on to find, however, that the Snyder bank was merely a trivial variation from the basic bank in the public domain. Although this court has the power to independently evaluate the presence or absence of the creative ele-

ment, we decline to do so. It is not necessary that we reach that issue because the Snyder bank satisfies the criteria for copyrightability in order to qualify as a reproduction of a work of art, as discussed in the following section.

III. "REPRODUCTION OF WORKS OF ART" AND COPYRIGHTABILITY

A reproduction of a work of art must satisfy the same standards for copyrightability as must any work of art. However, it would be self-contradictory to require that the reproduction display the same degree of creativity, when compared to the basic work of art, as if it were a conceptually independent production. The very idea of "reproduction" negates, within copyright law, the idea of an increment of difference inherent to the concept of "non-triviality," necessary to the creativity element. *Peter Pan Fabrics, Inc. v. Dan River Mills Inc.*, 295 F.Supp. 1366 (S.D.N.Y., 1969), *aff'd*. 415 F.2d 1067; *H. M. Kolbe Co. v. Armigus Textile Co.*, 184 F.Supp. 423 (S.D.N.Y., 1960), *aff'd*. 279 F.2d 555 (2d Cir.). That element—creativity—is supplied by the basic underlying work.

It is still requisite that the second element, originality of process, exist, for a reproduction of a work of art to merit copyright protection. As indicated above, Snyder has met his burden in this respect. Since Snyder's bank is entitled to a copyright, the district court erred in holding that Batlin is likely to prevail. On that basis, the court should have denied the injunction.

IV. CONCLUSION

At a trial on the merits or, alternatively, at proceedings before United States Customs Service, the parties are free to litigate the factual question of infringement.

At this juncture, it should be emphasized that the protection which attached to Snyder's work, as with any work, is limited to its creative increment. The greater the increment, the more protection is merited thereby.¹⁶ Thus Snyder is not able to appropriate the exclusive benefit of an article in the public domain, by being the first person to fabricate a slavish copy. In cases such as the instant one, it is the increment of difference from the basic version which is protected. *Axelbank v. Rony*, *supra*, 277 F.2d 314, 317; *Adventures in Good Eating v. Best Places to Eat*, *supra*, 131 F.2d 809, 813, n. 3; *Dorsey v. Old Surety Life Ins. Co.*, *supra*, 98 F.2d 872, 873; *American Code Co. Inc. v. Ben-singer*, *supra*, 282 F. 829, 834; *G. P. Putnam's Sons v. Lancer Books, Inc.*, 239 F.Supp. 782, 785 (S.D.N.Y., 1965); *Continental Casualty Co. v. Beardsley*, 151 F.Supp. 28, 32 (S.D.N.Y., 1957), *modified* 253 F.2d 702, *cert. denied*, 358 U.S. 816; *Smith v. George E. Muehlbach Brewing Co.*, *supra*, 140 F.Supp. 729, 731. See *Morrissey v. Proctor &*

16 This formulation applies equally well to articles using copyrighted materials as an inspiration or base. An author is not able to indefinitely prolong his copyright protection by making periodic changes. That person's copyright on the newer version protects only the creative increment and not the underlying basis after the old copyright expires. 17 U.S.C. §§ 3, 7. Section 3 provides:

"§ 3. Protection of component parts of work copyrighted; composite works or periodicals

The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title."

See *Caliga v. Inter Ocean Newspapers Co.*, 157 F. 186 (2d Cir.), *aff'd*, 215 U.S. 182 (1909); *Heim v. Universal Pictures Co.*, *supra*, 154 F.2d 480, 488, n. 17; *Adventures in Good Eating v. Best Places to Eat*, *supra*, 131 F.2d 809, 813; *Harold Lloyd Corp. v. Witwer*, *supra*, 65 F.2d 1, 24, *cert. denied*, 296 U.S. 669; *Andrews v. Guenther Pub. Co.*, 60 F.2d 555, 557 (S.D.N.Y., 1932).

Gamble Co., 379 F.2d 675, 678 (1st Cir., 1967). Snyder has staked out his claim to an adaptation of, or a reproduction of an object of art within the public domain, as he was entitled under the statutes. Batlin, on the other hand, is not prohibited from using the same basic bank as an inspiration for its product and from acquiring a copyright. Moreover, since the basic bank is in the public domain, the bank which Batlin was prohibited from importing does not infringe upon Snyder's design if it avoids pirating those increments which Snyder added to his original production. There may be many ways in which the changes in Batlin's bank can be clearly distinguished from Snyder's changes from the basic bank. *Sunset House Distributing Corp. v. Doran*, 304 F.2d 251, 252 (9th Cir., 1962); *Dymow v. Bolton*, *supra*, 11 F.2d 690, 691; *Allegrini v. DeAngelis*, 59 F.Supp. 248 (E.D.Pa., 1945), *aff'd*, 149 F.2d 815 (3d Cir.); *Barton Candy Corp. v. Tell Chocolate Novelties Corp.*, 178 F.Supp. 577, 581 (E.D.N.Y., 1959). On the merits Batlin may well succeed in making this distinction.

Since the district court based its preliminary injunction upon a finding that the Snyder bank is probably not copyrightable, and we hold otherwise, the injunction is vacated and the cause is remanded for further proceedings not inconsistent with this opinion.

OAKES, *Circuit Judge* (dissenting):

The majority opinion rendered today eviscerates this circuit's line of cases requiring a modicum of originality for copyrightability and in doing so opens the door to copyrights for slavish copies of any object in the public domain. Incidentally to doing so the majority also totally disregards the substantial evidence supporting Judge Metzner's findings that the likelihood that appellants can show

any input of originality to justify their copyright is small since change of material and change in size do not alone render an object copyrightable. The majority opinion cheapens copyrights (and the concept of copyright protection) by making them meaningless, supposedly in the name of "progress in the arts."¹ That opinion refers to the "increment of difference" required to supply copyrightability to works of art, but holds, *supra* at 6371, that the "very idea of reproduction" per se negates the established copyright law requirement that a nontrivial increment of difference exist in a "reproduction" of a work of art when compared with the work of art upon which it is based. Simultaneously, while allowing copyrightability here with no showing below of an "increment of difference,"² and with no explanation of what features constitute this increment, the majority goes on to say that the protection here attached to appellants' plastic toy bank is "limited to its creative increment" or that "it is the increment of difference from the basic version which is protected." *Id.* This seems to me to be judicial doubletalk. From the holding as well as the reasoning by which it is reached, I dissent.

Judge Metzner found that appellee, L. Batlin & Son, Inc., had shown through the testimony of its expert and through cross-examination of appellants' expert that the appellants' plastic bank did not evince the required "originality" to give ultimate probability of entitlement to copyright protection because it displayed "merely trivial variations" from the well-known antique metal bank now in the public

1 The constitutional clause authorizing Congress to enact patent and copyright legislation is "To promote the Progress of Science and useful Arts" U.S. Const. art. I, § 8(8).

2 The majority states, *supra* at 6370-71, that "[a]lthough this court has the power to independently evaluate the presence or absence of the creative element, we decline to do so. It is not necessary that we reach that issue"

domain from which or from a modern copy of which it was copied, relying, among other authorities, on *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951), and 1 M. Nimmer, *The Law of Copyright* § 20.3 (1975 ed.). The majority has come to the novel conclusion that "the requisite of originality was satisfied" merely because the district court found that "physical skill" was necessary to create the plastic bank and because, in the majority's view of the record, the person hired to sculpt the plastic mold needed "special skill, training and knowledge, and independent judgment." *Supra* at 6370. The majority evidently views the requirement that the bank be more than a "trivial variation" from the metal bank as part of the "creativity" requirement for works of art which does not apply to reproductions of works of art. Unfortunately, it is clear from the cases that the "trivial variation" standard is the heart of the *originality* requirement for both categories of works. Judge Metzner was entirely correct in concluding that appellants' argument that physical artistic skill was used in the production of the plastic bank fell short of making the required showing that the work displayed substantial variations from the metal bank.

The majority, in fashioning its unprecedented test that mere special skill and independent judgment suffice for originality in even the only trivially variant products, ignores the substantial evidence that comparatively small artistic skill and little independent judgment was involved in making the plastic bank, other than that skill and judgment required to transfer the metal design into the plastic medium with alterations dictated by the use of a different medium. The quality of artistic labor involved may be a relevant indicator of originality, but appellants' expert indicated that the time required to create the plastic work was a day and a half or two at most. Even where courts

have emphasized extraordinary skill and effort as buttressing a finding of originality, these qualities have been characterized in glowing phrases which are distinctly inapposite here. See *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 444 (2d Cir. 1960) (fabric designer effort required one month of work to give three-dimensional color effect to flat surface); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, *supra*, 191 F.2d at 104-05 n.22 (mezzotint engraver's art requires "great labor and talent"); *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959) (exact miniature of Rodin's Hand of God required "great skill and originality").

The polestar test of originality appeared in *Chamberlain v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945):

The first question with which we must deal is that of the validity of the copyright . . . Plaintiff [seeking infringement damages] therefore must lose unless he has shown that his work contains some substantial, not merely trivial originality and that defendant sold copies embodying the original aspects of his work.

This test was further elaborated in the leading case of *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, *supra*, 191 F.2d at 102-03, where Judge Frank said that "[a]ll that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"³ This has been echoed in case upon

³ It should, perhaps, be reemphasized that Judge Frank's opinion was issued in the context of upholding copyrights on mezzotints taken from paintings; he quotes at length from a description of the engraver's work, by which effects are produced "by the management of light and shade . . . produced by different lines and dots . . ." means "very different from those employed by the painter or draughtsman from whom he copies . . ." *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104-05 n.22 (2d Cir. 1951). A mezzotint by its nature cannot be a "slavish copy." Originality found by a trial judge on substantial evidence was thus upheld.

case in this circuit and elsewhere as a requirement of originality.⁴ To support a copyright, "a copy of something in the public domain" must present a "distinguishable variation." *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927).

Although the originality requirement may be minimal, this "does not prevent the court from concluding as a matter of fact that works may lack even the modicum of originality required." *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 782 (S.D.N.Y. 1968). Here, the appellants' plastic bank was admittedly sculpted into plastic using the more costly, metal Uncle Sam bank in the public domain as a model.⁵ Even if "[o]riginality in this context 'means little more than a prohibition of actual

⁴ See *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974); *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960); *Consolidated Music Publishers, Inc. v. Hansen Publications, Inc.*, 339 F. Supp. 1161, 1162-63 (S.D.N.Y. 1972); *Pantone, Inc. v. A.I. Friedman, Inc.*, 294 F. Supp. 545, 547 (S.D.N.Y. 1968); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776 (S.D. N.Y. 1968).

⁵ That the plastic bank was copied from the metal bank in virtually every detail was apparent to the experts, to the trial judge, and also from the exhibits submitted, to this writer as well; each has the same number of stars on Uncle Sam's hat, the same number of coat buttons, the same overall color scheme down to the green umbrella in his left hand, the same carpetbag opening the same way, the word "BANK" on the side of the base, an eagle facing right on the front of the base, etc., etc. It is apparent from a cursory reading of contemporary catalogs that metal copies of the originally patented but presently public domain metal banks are on the commercial market without the copyrighting of any of these products having come to the district court's or to our attention. See, e.g., catalog of The Gallery (Amsterdam, N.Y., 1974), at 1, 20; catalog of Carol Ann Gifts (Philadelphia, Pa., 1975) at 12, 22. Why a plastic rendition of the same idea and same expression is now entitled to copyright is hard to fathom. Presumably the metal mold-maker's "special skill, training and knowledge, and independent judgment" are in the same plane as the plastic sculptor's here involved. Does the majority opinion therefore permit a copyright to the metal copyists?

copying,' " *Rushton v. Vitale*, 218 F.2d 434, 435 (2d Cir. 1955), here we have just that.

The plastic bank's variations from the original or the up-dated version of the original also in the public domain consist essentially of three: a reduction in size from eleven to nine inches in height; the use of leaves instead of arrows in the clutches of the eagle at the base; and the joining of Uncle Sam's trousers at the ankle. But even the appellants' expert conceded that the steps performed in the copying of the metal bank into reduced plastic size involved changing some of the designs "in order to fit plastic." The district court refused to dignify these changes as an author's contribution of more than "trivial variation" and consigned the plastic bank to the class of items "slavishly copied" and undeserving of copyright protection. In doing so, Judge Metzner, an experienced district judge with more than a passing acquaintance with the arts, was clearly correct. As he stated,

I am making a finding of fact that as far as I'm concerned, it is practically an exact copy and whatever you point to in this [sic] differences are so infinitesimal they make no difference.

The majority decision, as I have said, cheapens copyrights by making them meaningless. If no originality in terms of variation, but only "physical skill" and "special training" by the author, need be shown as the opinion holds, anyone can copyright anything, calling it a "reproduction of a work of art." The majority, as if to back away from the purport of its decision, then goes on to say rather ambiguously that the protection afforded by the copyright it upholds on the appellants' plastic work is "limited to its creative increment." With no identification of either original or creative "increment" of variation, the

protection afforded appellants' reproduction is theoretically zero.

The majority has thus created an irreconcilable incongruity of implication in its holdings. As Nimmer points out,

Finally, it should be noted that copyright in a work of art protects against any substantial copying of the work per se, while copyright in a reproduction of a work of art protects only against the copying of the distinctive features contributed by the copyright owner of the reproduction.

1 M. Nimmer, *supra* § 20.3, at 95. Since the majority holds that the plastic work qualified as a "reproduction" without the necessity of possessing "distinctive features," the work has no features to be protected, and its copyright is worthless. Since the majority also implicitly holds that the skill necessary to recreate the work in plastic in slightly reduced size is a sufficiently "original" attribute, it may be that the majority has given appellants simultaneously total monopolistic protection against all competitors in the plastic medium. This is but one example of the bizarre contradictions which flow from the majority's treatment of the concept of "non-triviality" as absent in the "originality" requirement.

One could argue, I suppose, that this decision simply carries *Mazer v. Stein*, 347 U.S. 201 (1954), to its logical, if disputable,⁶ conclusion. But even while that case held

⁶ *Mazer v. Stein*, 347 U.S. 201 (1954) (statuette of Balinese dancer copyrightable despite intended use as base for table lamp), has not been without scholarly criticism. *E.g.*, Comment, *Copyright Protection for Mass-Produced Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. Chi. L. Rev. 807 (1971). But cf. Note, *Constitutional Limits on Copyright Protection*, 68 Harv. L. Rev. 517 (1955).

In recognizing that "the initial burden of excluding comm. place

that the statutory terms "works of art" and "reproduction of works of art"—clearly broader than the earlier term "works of the fine arts"—permit copyright of lamp-base statuettes, the Court expressly held that the objects to be copyrightable "must be original, that is, the author's tangible expression of his ideas." 347 U.S. at 214. No such originality, no such expression, no such ideas here appear. It is, I think, not insignificant that the *Mazer* majority cited for this proposition *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), which said:

It is, therefore, much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved, than in the case of a patent right.

Id. at 59-60. Whatever the validity of this as a proposition of law, the citation to it speaks in clarion tones to the element of originality missing here, as it is in the majority's analysis.

I will admit that some of our fabric design cases have gone far in upholding on an ad hoc basis copyrights of design copies on a "minimal quantum of originality," but this has been only "where the design printed is itself unmistakably original" and could be filed itself as a "work of art" under Section 5(g) of the Copyright Act, 17 U.S.C. § 5(g). *Supra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d

matters in the public domain, such as ideas, from copyright status has been left solely to the originality requirement . . . [which] does not perform this function very effectively," the Chicago writer has suggested removing the protection of mass-produced commercial articles entirely from the copyright system. Comment, *supra*, at 812, 823. I need not agree with the suggestion to agree with his conclusion that "[i]n any event . . . they [the articles] should be judged on their own merits." *Id.* at 823. The majority decision leaves us no standard for judging.

1092, 1094 (2d Cir. 1974); see also *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (1969). It has not been suggested by anyone that the original Uncle Sam bank or the modern metal copy from which appellants' plastic copy was copied, can be copyrighted at this late date.

In the forest of copyright cases referred to by the majority, the progenitor tree of originality has, I fear, been overlooked.

I would affirm the grant of the preliminary injunction.

③ United of the World, Airway's Plan.
1976

for Recommending Admission

